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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/644,380	08/23/2000	Floyd H. Chilton		1698

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EXAMINER

JIANG, SHAOJIA A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/01/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/644,380

Applicant(s)

CHILTON, FLOYD H.

Examiner

Shaojia A. Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 52-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 52-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

### DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 8, 2003 has been entered in Paper No. 15.

This Office Action is a response to Applicant's request for continued examination (RCE) filed April 8, 2003 in Paper No. 15, and preliminary amendment, filed April 8, 2003 in Paper No. 15 wherein claims 1-46 and 49-51 are cancelled, thus, all claims originally filed have been cancelled, and claims 52-55 are newly submitted.

Currently, claims 52-55 are pending in this application.

Claims 52-55 are examined on the merits herein.

This application is a CIP of PCT/US99/03120, WO 99/42101, which is a CIP of 09/028,256, now patented 6,107,334. However, the PCT, WO 99/42101 and the patent 6,107,334 upon, which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for the instant new claims 52-55 of this application for RCE since both WO 99/42101 and 6,107,334 do not disclose the particular composition herein consisting essentially of specific ingredients in specific amounts.

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***Claim Objection***

Claim 55 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the base claim 52 down to composition "consisting essentially of" recited ingredients. The composition of the base claim is actives recited therein. However, the transitional phrase "comprising" is employed in the dependent claim 55. The addition of further actives in dependent claims is broader than the scope of the base claim and therefore improper. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 52-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "about 19.29 weight percent water" in claim 52 renders claims 52-55 indefinite. The recitation "19.29 weight percent water" is not clear whether it means 19.29%. Applicant is reminded that the total percentage is 100%.

The recitation "minor ingredients" in claim 52 renders claims 52-55 indefinite. The recitation "minor ingredients" is not defined in the specification. Hence, one of ordinary skill in the art could not interpret the metes and bounds as to what "minor ingredients" are encompassed in the composition.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeMichele et al. (5,223,285, PTO-1449 submitted July 9, 2001) in view of Igarashi et al. (EP 782827, PTO-892) and Kahn et al. (4,154,863, PTO-892).

DeMichele et al. discloses that fish oils (marine oils) are well known to contain eicosapentaenic acid (EPA) and borage oil is also well known to contain  $\gamma$ -linolenic acid (GLA). Fish oils (marine oils) in 20% by weight and borage oil in 20% by weight are known to be used in a nutritional composition or a liquid nutritional product (see particular Table 2 at col.9 lines 32-65) according to DeMichele et al. The preferred nutritional compositions of DeMichele et al. comprise fish oil and borage oil, and water, sucrose, and stabilizer, and favoring agents (see col.15 line 65 to col.16 line 61, especially Table 7; Table 8 at col.17).

DeMichele et al. does not expressly disclose the employment of glycerin and particular minor ingredients in the particular composition herein. DeMichele et al. does not expressly disclose the particular amounts of the ingredients in the particular composition herein.

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Igarashi et al. teaches that glycerin is a well known food-additive and used in food or nutritional composition such as the composition therein comprising omega-3 and omega-6 unsaturated fatty acids (see page 15 line 37 and page 10).

Kahn et al. teaches that the instant minor ingredients such as xanthan gum (a known stabilizer for food composition), colorant, sorbic acid, and palmitate, are known to be used in a nutritional composition or food composition (see col.9 lines 21, 40, and 50, col.10 lines 15, 25-26, and 41-44, and particular compositions at col. 13 lines 50-67, col.15 lines 30-46, col.16 lines 20-34, col.17 lines 15-30, col.18 lines 11-24).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ glycerin and particular minor ingredients in a nutritional composition, and to optimize the amounts of the ingredients in a nutritional composition.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ glycerin and particular minor ingredients in a nutritional composition herein since glycerin is known to be useful in a nutritional composition comprising fatty acids according to Igarashi et al.

Additionally, one having ordinary skill in the art at the time the invention was made would have been motivated to employ the instant minor ingredients such as xanthan gum, colorant, sorbic acid, and palmitate in a nutrition composition since these ingredients are well known to be used in a nutritional composition or food composition according to Kahn et al.

Further, one of ordinary skill in the art would have been motivated to optimize the effective amounts of active ingredients in a nutritional composition or a food composition

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because the optimization of known effective amounts of known ingredients to be administered is considered well within conventional skills in food and nutritional science or industry, involving merely routine skill in the art. It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Thus the claimed invention as a whole is clearly prima facie obvious over the combined teachings of the prior art.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.



S. Anna Jiang, Ph.D.  
Patent Examiner, AU 1617  
June 18, 2003